



UNITED STATES PATENT AND TRADEMARK OFFICE



23474

12/12/2008

FLYNN THIEL BOUTELL & TANIS, P.C.
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Application No.:	10/551,675	Date Mailed:	12/12/2008
First Named Inventor:	Date, Takashi,	Examiner:	HESS, BRUCE H
Attorney Docket No.:	4364.P0013US <i>H. Tanaka</i>	Art Unit:	1794
Confirmation No.:	5519	Filing Date:	09/29/2005

Please find attached an Office communication concerning this application or proceeding.

FILE NO: HTNAK 13 ATTY: TFC
DUE DATE: 12-30-2008 (20081230)
4364.P0013US /INIT: (20080730)
ACTION: 10 RES PER: 5 M DK1
REFILE RCE (5TH MO AF) / 9025

Commissioner for Patents

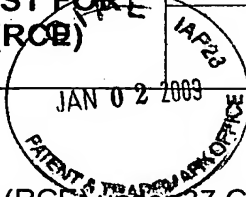
**NOTICE OF IMPROPER REQUEST FOR
CONTINUED EXAMINATION (RCE)**

Application No.
10/551,675

Applicant(s)
DATE ET AL.

Art Unit
1700

Date Mailed:



The request for continued examination (RCE) under 37 CFR 1.114 filed on 01 December, 2008 is improper for reason(s) indicated below:

1. ☐ Continued examination under 37 CFR 1.114 does not apply to an application for a design patent. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d). An RCE cannot be treated as a CPA.
2. ☐ Continued examination under 37 CFR 1.114 does not apply to an application that was filed before June 8, 1995. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b).
3. ☐ Continued examination under 37 CFR 1.114 does not apply to an application unless prosecution in the application is closed. If the RCE was accompanied by a reply to a non-final Office action, the reply will be entered and considered under 37 CFR 1.111. If the RCE was not accompanied by a reply, the time period set forth in the last Office action continues to run from the mailing date of that action.
4. ☐ The request was not filed before payment of the issue fee, and no petition under 37 CFR 1.313 was granted. If this application has not yet issued as a patent, applicant may wish to consider filing either a petition under 37 CFR 1.313 to withdraw this application from issue, or a continuing application under 37 CFR 1.53(b).
5. ☐ The request was not filed before abandonment of the application. The application was abandoned, or proceedings terminated on _____. Applicant may wish to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.
6. ☐ The request was not accompanied by the fee set forth in 37 CFR 1.17(e) as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.
7. ☒ The request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

Note: A continued prosecution application (CPA) under 37 CFR 1.53(d) cannot be filed in a utility or plant application. A CPA filed in a utility or plant application that has a filing date **on or after June 8, 1995** will be treated as an RCE under 37 CFR 1.114. The request for a CPA in the instant application, however, has been treated as an improper RCE for the reason(s) indicated above.

A copy of this Notice MUST be returned with the reply.

Direct any questions concerning this notice to

//Angela E. Jones//, Technology Center 1700

Telephone Number: 571-272-1022



IN THE U.S. PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

"Express Mail" Mailing Label No.: EM 212 650 675 US

Date of Mailing: December 1, 2008

Applicants: Takashi DATE et al

Title: THERMALLY-SENSITIVE RECORDING MATERIAL

Serial No.: 10/551 675

Group: 1794

Confirmation No.: 5519

Filed: September 29, 2005

Examiner: Hess

International Application No.: PCT/JP2004/004667

International Filing Date : March 31, 2004

Atty. Docket No.: 4364.P0013US

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAILED TO PATENT OFFICE
DATE DEC - 1 2008

EXPRESS MAILING CERTIFICATE

Sir:

I hereby certify that the attached paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

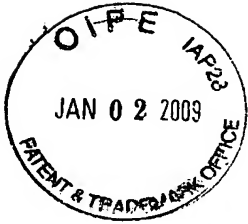
FLYNN, THIEL, BOUTELL & TANIS, P.C.

By: *Mia Skipper*

Date: December 1, 2008

Documents attached: RCE Application
Transmittal dated December 1, 2008
including enclosures listed thereon

Telephone: (269) 381-1156
191.05/05



IN THE U.S. PATENT AND TRADEMARK OFFICE
 Express Mail Label No. EM 212 650 675 US
 Attorney Docket No.: 4364.P0013US
 December 1, 2008

Mail Stop RCE
 Commissioner for Patents
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 Alexandria, VA 22313-1450

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REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL

Sir:

This is a Request for Continued Examination (RCE) under 37 CFR §1.114 of the below-identified pending utility or plant application:

Serial No.: 10/551 675

Filing Date: September 29, 2005

Confirmation No.: 5519

Title: THERMALLY-SENSITIVE RECORDING MATERIAL

Inventors: (1) Takashi DATE, (2) Junpei NATSUI,
 (3) Yoshimi MIDORIKAWA, (4) Tatsuo NAGAI
 and (5) Yoshihide KIMURA

Group: 1794

Examiner: Hess

Please direct correspondence to the address associated with the following customer number:

23474

FLYNN, THIEL, BOUTELL & TANIS, P.C.
 (FIRM)

1. Submission required under 37 CFR §1.114
 - a. ☐ An amendment under 37 CFR §1.116 previously filed on _____ was not entered. Please enter before calculating the filing fee.
 - b. ☒ Enclosed is/are:
 - i. ☐ Amendment/Response (please enter before calculating the filing fee)
 - ii. ☒ Affidavit(s)/Declaration(s)
 - iii. ☐ Information Disclosure Statement (IDS)
 - iv. ☒ Acknowledgment Post Card
 - v. ☒ Letter to Examiner.
2. Miscellaneous
 - a. ☐ Small entity status is claimed. See 37 CFR 1.27.
 - b. ☐ _____

3. Fees (The RCE fee under 37 CFR \$1.17(e) is required by 37 CFR \$1.114 when the RCE is filed).

a. ☒ The RCE fee and any filing fee for claims are calculated as shown below, after entering any amendments which this transmittal indicates are to be entered prior to such calculation:

For	No. Filed	No. Extra	(X) LG Entity	RATE	() SM Entity	Fee
Basic RCE Fee				\$810.00	\$405.00	\$810.00
Total Claims	(9 - 20 = 0)		x \$ 52.00		x \$ 26.00	
Indep. Claims	(4 - 4 = 0)		x 220.00		x \$110.00	
<input type="checkbox"/> Multiple Dep. Claim			+ \$390.00		+ \$195.00	
* * * TOTAL FILING FEE * * *						\$ 810.00

b. ☒ Pursuant to 37 CFR \$1.136(a), please extend the shortened period for response by one month. The extension fee is: \$130.00

c. ☐ Suspension of action on the above-identified application is requested under 37 CFR \$1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months). Suspension of action fee is \$_____ (37 CFR \$1.17(i)).

d. ☒ A check for \$940.00 is enclosed to cover fees.

e. ☐ Please charge my Deposit Account No. 06-1382 in the amount of \$_____.

f. ☒ The Commissioner is hereby authorized to charge payment of any additional application processing fees under 37 CFR \$1.17 associated with this communication or to credit any overpayment to Deposit Account No. 06-1382.

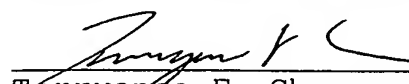
The undersigned is: ☒ an attorney of record

☐ acting under 37 CFR \$1.34.

Please direct all telephone calls to the undersigned at telephone number (269) 381-1156.

Respectfully submitted,

FLYNN, THIEL, BOUTELL & TANIS, P.C.


Terryence F. Chapman
Reg. No. 32 549

TFC/smd

Encl: Listed above

106.10/08

{00123993.doc}



PATENT APPLICATION

IN THE U.S. PATENT AND TRADEMARK OFFICE

December 1, 2008

Applicants: Takashi DATE et al

For: THERMALLY-SENSITIVE RECORDING MATERIAL

Serial No.: 10/551 675 Group: 1794

Confirmation No.: 5519

Filed: September 29, 2005 Examiner: Hess

International Application No.: PCT/JP2004/004667

International Filing Date: March 31, 2004

Atty. Docket No.: 4364.P0013US

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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LETTER TO EXAMINER

Sir:

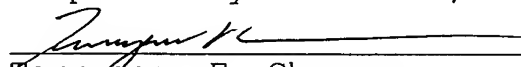
This request for continued examination is being presented in order to enter further evidence of the unobviousness of the presently claimed invention. That is, Applicants are enclosing herewith a Declaration Under 37 CFR 1.132 in which additional test data is presented which compares a thermally sensitive recording medium according to the present invention with additional comparative recording mediums prepared according to the disclosure of Hata et al.

In the outstanding Office Action, the Examiner states that the type of silica is not the only variable in Example 1 and Comparative Example 3 and that it appears that twice as much acrylic polymer/silica is employed in Example 1 as in Comparative Example 3. To address the Examiner's concerns, Applicants have prepared additional test data in which the spherical colloidal silica content and the acrylic polymer content are increased. As can be seen by the results in the enclosed Declaration, in revised Comparative Examples 3' and 3", in which the amount of silica and acrylic polymer was increased closer to that of Example 1 of the present application, the water resistance, printing aptitude and dregs on a head were inferior to that of the present invention.

Additionally, the color developing sensitivity was also inferior to that of the present invention.

Enclosed herewith for the Examiner's benefit is a document providing technical information about the colloidal silica composite synthetic resin emulsion used in Hata et al. As pointed out previously, where the silica and acrylic polymer are present as a composite or complex body particle type in which colloidal silica surrounding an acryl polymer, are strongly bonded by a polymerization bond, when it is used as a binder for a thermally sensitive layer, fusing or contacting of the acryl polymers to each other is hindered due to the presence of the colloidal silica and the film-forming ability is reduced. On the other hand, in the present invention where the acryl particles and colloidal silica are not added in the form of a composite, the colloidal silica combines with the acryl particles weakly by absorption and do not obstruct film formation between the acryl particles. This allows for the formation of a strong film so that the water-resistant property is improved along with the strength of the thermally sensitive recording layer and the printing aptitude. This is clearly unexpected in light of the prior art cited by the Examiner and establishes the patentability of the presently claimed invention thereover. Favorable consideration is respectfully solicited.

Respectfully submitted,


Terryence F. Chapman

TFC/smd

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Encl: Declaration Under 37 CFR 1.132
Clariant Technical Brochure